

REMARKS

Claim 5 has been amended. Claims 1-21 remain pending in the captioned case. Further examination and reconsideration of the presently claimed application are respectfully requested.

Section 101 Rejections

Claims 8-11 and 21 were rejected under 35 U.S.C. § 101 “because the computer-usable carrier medium as claimed is directed to intangible embodiments. As such, the claims are not limited to statutory subject matter and are therefore non-statutory. See *State Street*, 149 F.3d at 1374-75, 47 USPQ2d at 1602 (Fed. Cir. 1998) (MPEP 2106).” As described in more detail below, this rejection is respectfully traversed.

As set forth in MPEP 2106(II)(A), “[t]he claimed invention as a whole must accomplish a practical application. That is, it must produce a ‘useful, concrete and tangible result.’ *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02.” “A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See, *In re Warmerdam*, 33 F.3d 1354, 11360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).”

However, MPEP 2106.01 states that claims directed to computer-related inventions may be considered to produce a “useful, concrete and tangible result” when functional descriptive material is recorded on some computer-readable medium. In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases.

As shown in the above listing of claims, the preamble of claim 8 recites a “computer-usable carrier medium comprising a computer program.” The claimed “computer-usable carrier medium” may be implemented as any number of computer hardware components directly or indirectly disclosed in the present specification or commonly known in the art (e.g., various

processors, buses, interface units, storage devices/structures, peripheral devices, among others). As noted in MPEP 2106.01(I), “a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory.” A computer-usable carrier medium is considered to encompass computer-readable mediums (e.g., storage devices capable of recording computer programs), in addition to other computer hardware components. Regardless of the particular structure to which it is associated, recitation of the presently claimed computer program in conjunction with a physical structure (i.e., a computer-usable carrier medium) ensures that the subject matter recited in claims 8-11 and 21 will be statutory. Accordingly, removal of this rejection is respectfully requested.

Section 112, 2nd Paragraph, Rejections

Claim 5 was rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, claim 5 was rejected for lacking antecedent basis for the “on screen pointer” in line 4. To expedite prosecution, claim 5 has been amended in a manner believed to correct the antecedent basis. Accordingly, Applicants respectfully request removal of this rejection.

Section 103 Rejections

Claims 1-4, 8-9, 12, and 14-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,438,746 to Martin (hereinafter “Martin”) in view of U.S. Patent No. 6,865,713 to Bates et al. (hereinafter “Bates”). In addition, claims 5 and 10-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Martin, Bates, and U.S. Patent No. 6,026,233 to Shulman et al. (hereinafter “Shulman”). Furthermore, claims 6-7 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Martin, Bates, and U.S. Patent No. 4,541,048 to Propster et al. (hereinafter “Propster”).

To establish a case of *prima facie* obviousness of a claimed invention, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, there must be a reasonable expectation of success. As stated in MPEP 2143.01, the fact that references can be hypothetically combined or modified is not sufficient to establish a *prima facie* case of obviousness. See *In re Mills*, 916 F.2d. 680 (Fed. Cir. 1990). Finally, the prior art references must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d. 981 (CCPA 1974); MPEP 2143.03 (emphasis added). Specifically, “all words in a claim must be considered when judging the patentability of that claim against the prior art.” *In re Wilson* 424 F.2d. 1382 (CCPA 1970). Using these standards, Applicants contend that Martin and Bates fail to provide teaching or suggestion for all features of the currently pending claims, and furthermore, cannot be combined or modified to do so. Several distinctive features of the present invention are set forth in more detail below.

Martin and Bates fail to provide teaching, suggestion or motivation for a method of generating computer executable code, where the method includes creating a data set by modifying a comments portion of a program, and where the comments portion is modified by activating a user-selectable link embedded within the comments portion. Independent claim 1 recites in part, “[a] method for generating computer executable code, comprising: creating a data set by modifying a comments portion of a program, wherein said modifying comprises activating a user-selectable link embedded within the comments portion ...” Independent claim 15 recites a similar limitation.

As noted in previous responses to Office Actions, Martin simply fails to teach, suggest or provide motivation for creating a data set by modifying a comments portion of a program, where the comments portion is modified by activating a user-selectable link embedded within the comments portion. The Examiner appears to agree that such teaching cannot be found within Martin. For example, the Examiner states, “Martin differs from the claim in that Martin does not teach the data set is created by modifying a comments portion of a program by activating a user-selectable link embedded within the comments portion” (Office Action, page 3).

However, the Examiner suggests that Bates “teaches the data set is created by modifying a comments portion of a program by activating a user-selectable link embedded within the comments portion” (Office Action, page 4). Therefore, the Examiner concludes that it “would have been obvious to one of ordinary skill in the art, having the teaching of Martin and Bates before him at the time the invention was made, to modify the program generating system taught by Martin to include the teaching that the data set is created by modifying a comments portion of a program [as] taught by Bates with the motivation being to generate code from the comment portions when necessary” (Office Action, page 4). Applicants respectfully disagree. As described in more detail below, Bates fails to provide teaching or suggestion for all words of the limitation for which it is specifically relied upon. Furthermore, Bates cannot be modified or combined with Martin to provide teaching for the aforementioned limitation of present claims 1 and 15.

Bates discloses a method for annotating “a hypertext document with one or more comments to supply additional information to a user about that document and/or about other documents linked to that document” (Bates -- col. 3, lines 16-22). “If a comment for a given hypertext document indicates that the document would not be particularly useful, the user may decide to not retrieve the document, and thus save the time otherwise associated with retrieving and viewing the document” (Bates -- col. 3, lines 28-32). However, unlike the presently claimed case, Bates fails to disclose a method for generating computer executable code, and more specifically, fails to disclose the presently claimed method step of “creating a data set by modifying a comments portion of a program, where the comments portion is modified by activating a user-selectable link embedded within the comments portion.”

In general, Bates provides a method for displaying comments “to a user prior to the user attempting to retrieve any hypertext document associated with such comments, so that the user can make a more informed decision prior to retrieving the hypertext document” (Bates -- col. 3, lines 24-27). Bates discloses that comments may be displayed in two circumstances. For example, and as shown in Fig. 4 of Bates, a comment (85) associated with a hypertext document (70) being viewed in a browser may be displayed concurrently with the display of that document by displaying the comment in a window (e.g., window 84 near URL 71) (Bates -- col. 8, lines

52-64; Fig. 4). On the other hand, a comment (94) may be displayed in response to a pointer (90) being moved over a hypertext link (76) included within the document (70), such that the comment is displayed in a pop-up window (92) (Bates -- col. 8, line 65 – column 9, line 11). In most cases, the comments (e.g., comments 85 and 94) are added to the document to provide additional information to the user. For example, comment 85 indicates to the user that “[t]his is a very helpful site on network security” (Bates -- Fig. 4). This is altogether different from the presently claimed case, which uses comments to generate executable code.

As noted above, the Examiner relies on Bates for allegedly teaching the claimed step of “creating a data set by modifying a comments portion of a program, where the comments portion is modified by activating a user-selectable link embedded within the comments portion.” (Office Action, page 4). The Applicants contend that Bates may provide teaching for a small portion of the limitation (i.e., for creating a data set by modifying a comments portion of a program). This is illustrated, for example, in Figs. 12 and 13 of Bates. In these figures, Bates discloses that an additional comment may be added to a comment list (in block 210 of Fig. 12) when the user selects the “add comment” feature from a browser pop-up menu (e.g., pop-up menu 222 of Fig. 13) associated with a particular hypertext link (e.g., link 76 of Fig. 13) (Bates -- col. 11, lines 14-28; col. 15, lines 42-52; col. 16, lines 10-27; Figs. 12-13). The method of Bates also enables a comment to be edited (in block 214 of Fig. 12) by selecting a “delete comment,” “edit comment,” or “adjust priority” feature from the browser pop-up menu (Bates -- col. 14, lines 5-39; col. 15, lines 52-57). As noted above, the comments added to the comment list may be displayed in a comment window (e.g., comment windows 84 or 92 of Fig. 4 or comment window 226 of Fig. 13) of the document (e.g., document 70 of Figs. 4 and 13). Therefore, Bates appears to provide teaching for creating a data set (i.e., a comments list) by modifying (e.g., adding or editing comments from) a comments portion (e.g., comment window 226) of a program (e.g., document 70).

However, like Martin, Bates simply fails to teach or suggest that the comment window (i.e., the alleged “comments portion”) may be modified by activating a user-selectable link embedded within the comment window. In other words, like Martin, Bates fails to provide teaching or suggestion for all words recited in the aforementioned limitation. As set forth in

MPEP 2143.03, the prior art references must teach or suggest all claim limitations. *In re Royka*, 490 F.2d. 981 (CCPA 1974). Specifically, “all words in a claim must be considered when judging the patentability of that claim against the prior art.” *In re Wilson* 424 F.2d. 1382 (CCPA 1970). Support for the lack of teaching, suggestion or motivation within Bates is provided in more detail below.

Bates discloses that a user-selectable link (e.g., hypertext link 234, Fig. 13) may be included within the comments portion (e.g., comment window 226, Fig. 13) of the program (e.g., document 70, Fig. 13) to specify an additional hypertext document that can be navigated to via user selection of the link. In other words, Bates teaches that hypertext link 234 may be activated or selected by the user to navigate to another document, which is specified in the comment. (See, e.g., Bates, column 15, lines 58-67 and column 16, lines 27-34). However, Bates fails to teach or suggest that hypertext link 234 may be activated to modify the comments portion of the program (e.g., comments window 226 containing the comments list). Hypertext link 234 is used only for navigational purposes. Therefore, even though Bates may include a user-selectable link (hypertext link 234) within a comments portion (comment window 226) of a program (document 70), Bates fails to provide teaching or suggestion for modifying the comments portion of the program by activating the user selectable link embedded within the comments portion. As a consequence, Bates fails to provide teaching or suggestion for all words of the limitation for which it is specifically relied upon.

NOTE: the browser pop-up menu (e.g., pop-up menu 222 of Fig. 13) mentioned above is not used to display a comments list and, therefore, cannot be considered a comments portion (e.g., comment window 226 of Fig. 13) of the program.

In addition to explicit lack of teaching or suggestion, Bates lacks the necessary motivation that would enable one skilled in the art to modify the teachings of Bates to provide the aforementioned limitation. Although Bates notes that “other executable-type code may be embedded in a comment to permit other operations to occur as a result of user manipulation of comment text” (Bates -- col. 16, lines 1-3), Bates provides absolutely no indication that the “executable-type code” (which is vaguely described as permitting “other operations to occur”)

may be activated via user selection for modifying the comments portion (e.g., comment window 226) of the program. Without the necessary motivation to do so, Bates cannot be modified to provide teaching or suggestion for modifying the comments portion of a program by activating a user selectable link embedded within the comments portion. As such, Bates fails to provide teaching, suggestion or motivation for all limitations recited in present claims 1 and 15.

Finally, Bates cannot be combined with Martin to overcome the deficiencies therein. As noted above, Martin and Bates each fail to provide the necessary teaching or suggestion for creating a data set by modifying a comments portion of a program, where the comments portion is modified by activating a user selectable link embedded within the comments portion of a program. In addition, Martin and Bates each lack the necessary motivation that would enable one skilled in the art to modify their respective teachings to provide the aforementioned limitation. Therefore, even if the teachings of Martin and Bates were combined (without sufficient motivation to do so), the combined teachings of the cited art would still fail to provide teaching or suggestion for all limitations of present claims 1 and 15.

The cited art fails to provide teaching, suggestion or motivation for a first text, which is preceded by a comments designator and succeeded by at least one link word that is adapted for modification by an on-screen pointer, wherein modification to the link word causes a data set to change. Independent claim 8 recites in part, “[a] computer-usable carrier medium comprising a computer program, wherein the computer program comprises: a first text preceded by a comments designator and succeeded by at least one link word that is adapted for modification by an on-screen pointer; and a second text displayed on a display device along with the first text for presenting a data set that changes dependent on modification to the link word by the on-screen pointer ...”

As noted in various responses to previous Office Actions and in the Supplemental Appeal Brief mailed July 20, 2006, Martin fails to provide teaching, suggestion or motivation for the presently claimed “first text,” which is preceded by a comments designator and succeeded by at least one link word that is adapted for modification by an on-screen pointer. The Examiner appears to agree. For example, the Examiner admits that “Martin differs from the claim in that

Martin does not teach that the comments designator may be succeeded by a link word [that] is adapted for modification by an on-screen pointer” (Office Action, pages 4-5).

However, the Examiner contends that Martin provides teaching for a data set that changes dependent on modification to a link symbol (the “=” symbol shown in part 1000b of Fig. 9), and further suggests that Bates “teaches that the comment (text) includes a link word that can be modified by an on-screen pointer (col. 8, lines 1-13)” (Office Action, pages 4 and 5). Therefore, the Examiner concludes that it “would have been obvious to one of ordinary skill in the art, having the teaching of Martin and Bates before him at the time the invention was made, to modify the program generating system taught by Martin to include the teaching that [a] link word ... can be modified by an on-screen pointer [as] taught by Bates with the motivation being to enable the system to quickly and efficiently modify the comment portion” (Office Action, page 5). Applicants respectfully disagree. As described in more detail below, Bates cannot be combined with Martin to overcome the deficiencies therein.

Contrary to the Examiner’s suggestions, Martin does not provide teaching or suggestion for a data set, which changes dependent on modification to a link word. Throughout prosecution, the Examiner repeatedly suggests that the “=” symbol shown in part 1000b of Fig. 9 is somehow equivalent to the presently claimed “link word” (Office Action, page 4). The Applicants strongly disagree. As stated previously, the “=” symbol is merely an assignment symbol and is not adapted for modification by an on-screen pointer. In addition, although Martin discloses that the comment text following the comment designator in part 1000b of Fig. 9 may be used “in generating new compilable C++ code and in generating directives to the compiler” (Martin -- col. 8, lines 60-62), Martin does not teach or suggest that changes to the generated C++ code or directives (i.e., the alleged “data set”) is somehow dependent on modification to the “=” symbol (i.e., the alleged “link word”). If anything, changes to the C++ code or directives (i.e., the alleged “data set”) could be made by changing the specification data following the “=” symbol (e.g., changing the availability in line 1002b from 99.9% to some other value). However, such changes would not be dependent on modification to the link word (or link symbol) itself. Therefore, Martin cannot be relied upon to provide teaching or suggestion for a data set, which changes dependent on modification to a link word.

The teachings of Bates cannot be combined with those of Martin to overcome the deficiencies therein. As noted above, the Examiner relies on Bates for allegedly teaching “that the comment (text) includes a link word that can be modified by an on-screen pointer (col. 8, lines 1-13)” (Office Action, pages 4 and 5). However, Bates fails to provide teaching or suggestion for the “link word” as set forth in present claim 8, and therefore, cannot be combined with Martin to overcome the deficiencies therein.

As noted above, Bates suggests that a hypertext link (e.g., hypertext link 234, Fig. 13) may be included within comment text (e.g., comment text 228, Fig. 13) to enable a user to navigate to another document (*see*, Bates column 8, lines 1-13, and column 16, lines 27-34). Thus, the Examiner seems to suggest that the comment text (e.g., comment text 228, Fig. 13) is somehow equivalent to the presently claimed “first text,” and that the hypertext link (e.g., hypertext link 234, Fig. 13) is somehow equivalent to the presently claimed “link word.” Applicants respectfully disagree.

First of all, Bates does not teach or suggest that the comment text (e.g., comment text 228, Fig. 13) is preceded by a comments designator (such as the “//” designator used in the C programming platform), as specifically required by present claim 8. Second, although Bates suggests that a hypertext link (e.g., hypertext link 234 of Fig. 13) may be included within the comment text to enable a user to navigate to another document, Bates does not teach or suggest that the hypertext link may be adapted for modification by the on-screen pointer, wherein modification to the hypertext link causes a data set to change.

As noted above, hypertext links (such as link 234) are included within the comment text (such as comment text 228) to enable a user to navigate to another document, which is specified in the comments portion. However, Bates does not use hypertext links (such as link 234) for modifying a comments portion (e.g., comment window 226) of a program, or for creating a data set (e.g., a comment list) that changes dependent on modification to the hypertext link. As such, any “link words” that may be disclosed by Bates (such as hypertext link 234) are not equivalent to the presently claimed “link word,” making it impossible for the comment text (such as

comment text 228) disclosed by Bates to be considered equivalent to the presently claimed “first text.”

For at least the foregoing reasons, Martin and Bates each fail to provide teaching or suggestion for the presently claimed first text, which is preceded by a comments designator and succeeded by at least one link word that is adapted for modification by an on-screen pointer, wherein modification to the link word causes a data set to change. Therefore, even if Bates were combined with Martin (in the absence of sufficient motivation to do so), the combined teachings of the cited art would still fail to disclose all limitations of present claim 8.

For at least the reasons set forth above, Martin and Bates each fail, both separately and in combination, to provide teaching or suggestion for all limitations recited in present claims 1, 8, and 15. The limitations of independent claims 1, 8, and 15 are also not taught or suggested by Shulman or Propster. As a result, present claims 1, 8, and 15, as well as claims dependent therefrom, are patentably distinct over the teachings of the cited art. Accordingly, Applicant respectfully request this rejection be removed.

CONCLUSION

The present amendment and response is believed to be a complete response to the issues raised in the Office Action mailed October 19, 2006. In view of the remarks herein, Applicants assert that pending claims 1-21 are in condition for allowance. If the Examiner has any questions, comments or suggestions, the undersigned attorney earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Daffer McDaniel, LLP Deposit Account No. 50-3268/5298-05300.

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